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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,439	06/14/2006	Adrian Shulman	225 06 01 NP US	6727
36131	7590	08/02/2010	EXAMINER	
YORAM TSIVION			RAMANA, ANURADHA	
P.O. BOX 1307				
PARDES HANNA, 37111			ART UNIT	PAPER NUMBER
ISRAEL			3775	
			NOTIFICATION DATE	DELIVERY MODE
			08/02/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

erikav@patent2u.co.il  
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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/596,439	SHULMAN, ADRIAN
	<b>Examiner</b>	<b>Art Unit</b>
	Anu Ramana	3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 July 2009.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.  
 4a) Of the above claim(s) 2 and 3 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,4-13,17 and 18 is/are rejected.  
 7) Claim(s) 14-16 and 19 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 8/8/2008 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Claim Objections***

Claim amendments must be made consistent with 37 CFR 1.121(c). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Brosens et al. (US 6156006).

Brosens et al. disclose a vaginal speculum assembly including: a first jaw 640 having a first truncated engagement portion; a second jaw 642 pivotally connected to the first jaw, the second jaw having a second engagement portion; a first handle portion generally perpendicular to the first engagement portion; a second handle portion generally perpendicular to the second engagement portion; and a guide section or "mounting mechanism" 644 removably mounted to the first jaw to support an instrument or "inspection device" or combined Veress needle guide and ultrasound probe apparatus 700 wherein the mounting mechanism is detachable from the first jaw (Figs. 18-19 and col. 17, lines 21-52 and col. 18, lines 1-13).

Claims 1, 4-6, 8-10, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (US 3320948).

Martin discloses a vaginal speculum assembly including: a first jaw 11 having a first truncated engagement portion; a second 14 pivotally connected to the first jaw, the second jaw having a second engagement portion; a first handle portion generally

perpendicular to the first engagement portion; a second handle portion 23 generally perpendicular to the second engagement portion; and a mounting mechanism 4 removably mounted to the first jaw to support an instrument or "inspection device" wherein the mounting mechanism is detachable from the first jaw. The mounting mechanism includes a locking mechanism or fastener 61 that prevents movement of the inserted instrument with respect to the first jaw. Martin further discloses the mounting mechanism to have a rocker or housing or first clamping element 40 connected to a shaft 31 and a second clamping element 35 pivotally receiving first clamping element 40 (Fig. 3, col. 3, lines 44-75, col. 4 and col. 5, lines 1-15).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brosens et al. (US 6156006) in view of Tepper (US 6371973).

Brosens et al. disclose all elements of the claimed invention except for the specific details of the mounting mechanism or mounting configuration.

Tepper teaches an instrument mount including: a housing 32 that receives a shaft of an instrument within; first clamping element 34; a second clamping element or locking mechanism 35 that when engaged or locked to second clamping element 35 prevents movement of an instrument such as an ultrasound probe with respect to the instrument that it is attached to; and a fastener or pins 44 that secure the first clamping element to housing 32 (Fig. 3, col. 7, lines 26-67 and col. 8, lines 1-17).

The substitution of one known instrument mounting mechanism (as taught by Tepper) for another known instrument mounting mechanism (as disclosed by Brosens et al.) would have been obvious to one of ordinary skill in the art at the time of the

invention since this amounts to simple substitution of one known type of mounting mechanism for another and would have yielded predictable results, namely, removable attachment of an ultrasound probe to an instrument, for e.g. a speculum.

### ***Response to Arguments***

Applicant's arguments filed on July 16, 2010 have been fully considered.

Applicant's arguments with respect to the rejection of claims 1 and 4-8 under 35 USC 102(b) as being anticipated by Brosens et al. are not persuasive because Applicant is not positively reciting an ultrasonic probe. The Brosens et al. device is fully capable of supporting an inspection device such as an ultrasonic probe. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Applicant's arguments are also directed to unclaimed features. For e.g., "an ultrasonic probe of a preferable shape (page 5)," and "degrees of freedom in positioning of the ultrasonic probe (page 7)."

Applicant's arguments with respect to the rejection of claims 1, 4-6, 8-10, 17 and 18 over Martin, it is noted that Applicant is not positively reciting an ultrasonic probe in claim 1.

Regarding the combination of Brosens et al. and Tepper, in response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one of ordinary skill in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what

they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, Tepper discloses a mounting mechanism for removably mounting an ultrasonic probe to a surgical instrument used in intra-uterine, cervical and tubal procedures to enable counter-resisted movement of the ultrasonic probe with respect to the surgical instrument.

The Examiner has noted the Annex provided with the response filed on July 16, 2010. However, the evidence provided is not commensurate in scope with the claimed invention. Thus, the evidence cannot be given substantial weight in route to a conclusion on the obviousness issue.

#### ***Allowable Subject Matter***

Claims 14-16 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-

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4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached at (571) 272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
July 26, 2010

/Anu Ramana/  
Primary Examiner, Art Unit 3775